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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/632,703

08/01/2003

Gary Smith

0241-P02965US2

3628

110 7590 09/16/2008
DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER

CHARLES, MARCUS

ART UNIT

PAPER NUMBER

3682

MAIL DATE

DELIVERY MODE

09/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/632,703	Applicant(s) SMITH ET AL.	
	Examiner Marcus Charles	Art Unit 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 25-35 and 37-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23, 25-35 and 37-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5-16-2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the amendment filed 5-16-2006, which has been entered.

Claim 1-23, 25-35 and 37-47 are currently pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-23, 25-35 and 37-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP403-163245) in view of JP (04-3477043) and St. John (4,957,471). JP403-163245) discloses the claimed invention including the tensioner comprising a housing (26) with an open lower end, a base (3) with a closed end (11) closing the opened lower end of the housing, a first connector on the base (see 20/17), a shaft (13) disposed within the housing and projecting upwardly from the base and fixedly attached to the base, an arm having first and second ends with a second connector (see connection between 20 and (20/17) on the first end, a bearing (28) disposed within the housing and connected to the shaft and the housing so that the housing is rotatable relative to the base, a reversible biasing element (7) disposed in the housing and inherently providing a torque to bias the housing relative to the base in first and second clockwise and anticlockwise directions. It is apparent that the biasing spring is capable of being removed and diametrically replaced so that the biasing force is opposite the first biasing. JP (403-163245) is silent concerning rearranging the spring so that it

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biases the arm in the reverse direction. An example can be found in EP (0482382), which discloses a tensioner having a spring (40) biasing an arm (10) in a first direction (note the direction of the end of the spring engaging the post (11) in fig. 6), and the spring (150) biasing the arm (110) in a reverse direction. Therefore, the biasing element is inherently reversible. JP03-163245) does not disclose the first connector of the housing is cooperable with a second connector of the arm to attach the arm to the housing. JP (04-347043) discloses a tensioner having a housing (11) with a lower end, an arm (4) having an end with a connector (4a/5) cooperable with the connector (11b) of the housing to attach the arm to the housing. Therefore, it would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the tensioner of JP403-163245) so that the arm is removable attached to the housing in view of JP (04-347043) in order to be able manipulate/adjust the arm without interfering with the housing. In addition, JP403-163245) does not disclose an indicator for indicating the direction of the biasing element. St John discloses a tensioner comprising an indicator (114 and a button on pointer 15, see attached drawing illustration) that inherently indicates the rotational movement of the arm and to indicate the amount of tension in the system and the amount of torque in the spring. If the direction of the spring is reversed, the direction of the pointer will be in the opposite towards the left or the ring of the indicator (14), thus indicating the preferred direction of the biasing forces in the relax state. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of JP403-163245) to include an indicator in

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view of St. John in order to indicate the amount of tension in the system and the amount of torque in the spring.

In claim 2, note the indicator is cooperable with/* the spring to indicate the direction of the biasing force.

In claim 3, Note the indicator is capable of indicating the direction of the biasing force.

In claims 4-6, 8-22, 25-33 and 41-47, the prior art inherently indicates the claimed invention.

In claims 34-35 and 37-40, the method claims are inherently included during the operation of the combination of JP403-163245), JP (04-3477043) and St. John device.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-23 and 25-35 and 37-47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S.

Patent No. 6,855,079. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because they are obvious variations in breath and scope.

Response to Arguments

5. Applicant's arguments, filed 5-16-2008, with respect to the Cura reference relating to the 35 USC 102 second paragraph rejection have been fully considered and are persuasive. The 102 second paragraph rejection of Cura has been withdrawn.

6. Applicant's arguments filed 5-16-2008 relating to the 35 USC 103(a) rejection have been fully considered but they are not persuasive. Applicant indicated that the St. John (471') is not correct from a technical stand point and the St. John device cannot detect the amount of torque in the spring because St. John does not use a spring to bias the arm (11) but is directed to a frictional type tensioner. In response, it should be noted that the tensioner of St. John includes a torsion biasing element (218, 418) that produces a torque on the arm to move in a particular direction. In addition, St. John clearly discloses the torsion biasing element performs a number of functions including (1) permitting same rotation between the arm and the torque plate. In addition, the torsion biasing element allows the tensioner to act as an automatic tensioner, and (2) viscous damping (see col. 6, lines 10-34). Therefore, it can be understood that the biasing element functions to bias the arm to produce a torque to provide a tension on the belt and the indicator functions to determine the amount of tension and the direction of the tension even in the relax state. In the relax state the indicator would move either to the far right or the far left to indicate the preferred direction.

Regarding arguments relating to the double patenting rejection, applicant contended that the double patenting is based on the premise that St. John teaches or suggest features of the pending claims that render the claims obvious over the claims of US 6,855,079. It should be noted that the double patenting rejection was not an obvious type rejection in view St. John as a second reference but an obvious type double patenting rejection with no secondary reference. Therefore, applicant fails to properly address the Double patenting rejection. Therefore, for reasons given above the rejection is deemed proper.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus Charles whose telephone number is (571) 272-7101. The examiner can normally be reached on Monday-Thursday 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ridley Richard can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcus Charles
/Marcus Charles/
Primary Examiner, Art Unit 3682